

a drive pinion mounted to the cartridge access device, said drive pinion engaging said elongate gear rack; and pinion drive means operatively associated with said drive pinion for rotating said first drive pinion to move the cartridge access device along the displacement path.

REMARKS

Claims 1, 13, and 24 are amended. Claims 1, and 3-24 remain for consideration. Re-examination and reconsideration are requested.

In the Final Office Action, the examiner rejected claims 1, 3-7, 12-19, and 24 under 35 U.S.C. § 102(e) as being anticipated by Tadokoro, et al. (U.S. Patent No. 6,166,877 (Tadokoro)). This rejection was made final.

The examiner did not make any substantive rejections with respect to claims 8-11, and 20-23. Therefore, with the exception of the provisional double-patenting rejection with respect to these claims, the applicants believe that the examiner will allow these claims.

Applicants believe that all of the pending claims are not anticipated by, nor obvious over the cited references and respectfully traverses the examiner's rejections for the reasons that will be set forth below.

Re the Claims:

Independent claims 1, 13, and 24 have been amended to more clearly define the limitation that the guide member and gear rack

are both formed as a single unit (in other words, "integral"). The applicants respectfully request that these amendments be entered as they either place the claims in condition for allowance or place the claims in better condition for appeal, should that become necessary. Specifically:

Claim 1, as twice amended, recites "a first elongate guide member formed as a single unit with said first elongate gear rack . . .".

Claim 13, as twice amended, recites the first elongate guide member is "formed as a single unit with" the first elongate gear rack.

Claim 24, as twice amended, has been amended to recite the guide means is "formed as a single unit with" the elongate gear rack.

Legal Standard For Rejecting Claims Under 35 U.S.C. § 102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (finding that the jury had been erroneously instructed that anticipation may be shown by equivalents, a legal theory

that is pertinent to obviousness under Section 103, not to anticipation under Section 102). "The identical invention must be shown in as complete detail as is contained in the patent claim." MPEP, §2131 (8th Ed. 2001) (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

"It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office." *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). The examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the applicants.

Discussion of the Reference

Tadokoro, et al., U.S. Patent No. 6,166,877 (Tadokoro): The Tadokoro reference discloses a cassette auto-changer system including, among other things, a selection member for selecting between a plurality of cassettes. In particular, with respect to the embodiment shown in FIG. 19, FIG. 20, and FIG. 21, Tadokoro discloses a cassette transfer mechanism 2 with upper and lower horizontally-arranged rack members 32, 32 disposed so as to engage the upper and lower guide rails 8, 8 disposed on each of

the consoles A-D. A vertical pillar 30 is supported between the upper and lower rack members 32 so as to be movable in a horizontal plane. Upper and lower end portions 30a, 30b attached to each end of the pillar 30 include a plurality of guide rollers 33 for pressingly engaging the guide rails 8 at three sides thereof to provide stable support and rolling movement for the cassette transport mechanism 2. A pulley 35 mounted on the drive shaft of the motor 34 engages a timing belt, which further engages a drive pulley 37 on rotatable shaft 38. Drive gears 29, 29 are engaged with adjacent reduction gears 40, 40 at each side thereof. Smaller pinion gears are coaxially disposed at upper sides of the upper reduction gears 40, 40 and lower sides of the lower reduction gears 40, 40 to engage horizontal rack gear teeth formed on the upper and lower rack members 32, 32.

Argument

Claims 1, 3-7, 12-19, and 24 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,166,877 to Tadokoro, et al. (hereinafter, "Tadokoro") for the reasons set forth in the Final Office Action. However, none of the cited references disclose or make obvious a translation apparatus that meets each of the limitations of each of the currently pending claims.

In response to the applicants' amendments and arguments submitted on August 9, 2001, the examiner contends that the term "integral" is not necessarily restricted to a one-piece article, and that the courts define the term "integral" as "rigidly secured, fastened or welded." However, the examiner does not cite to any particular case where the court defined the term

"integral" as such. Nor does the applicants' specification support such a broad interpretation of the claim language. Therefore, while the applicants do not concede that the term "integral" may be so broadly defined absent further substantiation by the examiner, in the interest of expediting examination of the application, the applicants have amended the claims as set forth above to more clearly specify that the claimed translation apparatus is restricted to a one-piece article. As discussed in more detail below, these limitations are not disclosed in, nor obvious in view of, Tadokoro.

The examiner asserts that the limitations of a guide member and bearing are anticipated by Tadokoro. Specifically, with reference to FIG. 20 and FIG. 21, Tadokoro shows rack members 32 engaging upper and lower guide rails 8, and a plurality of guide rollers 33 pressingly engaging the guide rails 8 (see specification Col. 14, lines 9-20). However, the guide member and gear rack disclosed in Tadokoro are not formed as a single unit. Instead, the guide rails 8 disclosed in Tadokoro are separately connected to the rack members 32. As Tadokoro does not teach every element of the applicants' claims, the reference does not anticipate the applicants' invention under 35 U.S.C. § 102(e). MPEP, §2131 (8th Ed. 2001).

The examiner has also failed to make a prima facie case of obviousness under 35 U.S.C. § 103. The examiner contends that there is nothing to preclude the guide member and gear rack of Tadokoro from achieving the same or similar results as those realized by the applicants' invention. However, the examiner does not cite to any teaching or suggestion in the art to support this contention. If the examiner is relying upon personal knowledge of the art, the applicants request that the examiner submit

documentary evidence of such personal knowledge. MPEP 2144.03 ("When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.").

However, contrary to the examiner's position, the design disclosed by Tadokoro, in which the guide member and gear rack are formed as separate units and mounted to one another, increases the likelihood that the gears 41 and the rack members 32 are misaligned during assembly. Such misalignment may result in binding, slipping, and/or uneven wear of the gears 41 and the rack members 32.

The applicants' invention, on the other hand, requires that the guide member (e.g., portion 50) and the gear rack (e.g., 20) be formed as a single unit, as shown in FIG. 1, FIG. 2, and FIG. 3. For example, "in one preferred embodiment, both the lower and upper gear racks 20 and 22 are fabricated from sheet metal with the respective guide member portions 50 and 52 thereof comprising up-turned and down-turned edge portions, respectively" (see specification page 11, lines 31-35). As such, the guide member and gear rack formed as a single unit reduces part count and eliminates an assembly step that would otherwise require precision to ensure that the guide rail is assembled to the gear rack within required tolerances to avoid misalignment of one with the other. These advantages are clearly not present in the design disclosed by Tadokoro.

For at least the above reasons, the applicants believe that independent claims 1, 13, and 24, each as twice amended, are not anticipated by, nor obvious in view of, Tadokoro. The examiner

also asserts § 102(e) rejections against dependent claims 3-7, 12, and 14-19. As the independent claims from which these claims depend are not anticipated by, nor obvious in view of, Tadokoro, it follows that the dependent claims are also not anticipated by, nor obvious in view of, Tadokoro. As such, although each of the dependent claims are also believed to be allowable on their own grounds, these claims will not be discussed in further detail herein.

Provisional Rejection of Claims 1 and 3-24 under Obviousness-Type Double Patenting:

The examiner provisionally rejected claims 1 and 3-24 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of commonly-owned pending U.S. Patent Application Serial No. 09/371,708. The applicants will respond to this issue upon the indication that the claims are otherwise allowable.

CONCLUSION

Applicants believe that all of the claims currently pending in this patent application, as amended and as discussed above, are allowable and that all other problems raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider his rejections and to grant an early allowance. If any questions or issues remain to be resolved, the

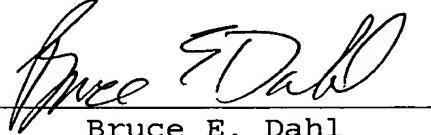
-11-

examiner is requested to contact the applicants' attorney at the telephone number below.

Respectfully Submitted,

DAHL & OSTERLOTH, L.L.P.

By:



Bruce E. Dahl

Reg. No. 33,670

555 17th Street, Suite 3405
Denver, Colorado 80202
Tel.: (303) 291-3200
FAX: (303) 291-3201

Date: 12-14-01

APPENDIX

CHANGES MADE TO CLAIMS

Claim 1 has been amended as follows:

1. (Twice Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

a first elongate gear rack aligned along the displacement path, said first elongate gear rack having a ^{peripheral} _{one} ^{and} first end and a second end;

a first elongate guide member formed as a single unit [integral] with said first elongate gear rack and extending along the displacement path substantially between the first and second ends of said first elongate gear rack;

a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member;

a second elongate gear rack aligned along the displacement path and positioned in spaced-apart relation to said first elongate gear rack, said second elongate gear rack having a first end and a second end;

a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;

a second drive pinion mounted to the cartridge access device, said second drive pinion engaging said second elongate gear rack; and

pinion drive apparatus operatively associated with said first and second drive pinions, said pinion drive apparatus rotating said first and second drive pinions to move the cartridge access device between the first and second ends of said first and second elongate gear racks.

Claim 13 has been amended as follows:

13. (Twice Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

a first elongate gear rack aligned along said displacement path, said first elongate gear rack having a first end and a second end;

a first elongate guide member formed as a single unit [integral] with said first elongate gear rack so that said first elongate guide member extends along the displacement path;

a second elongate guide member extending along the displacement path and positioned in spaced-apart relation to said first elongate guide member;

a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;

a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member;

a second bearing mounted to the cartridge access device, said second bearing engaging said second elongate guide member; and

pinion drive apparatus operatively associated with said first drive pinion, said pinion drive apparatus rotating said first drive pinion to move the cartridge access device along the displacement path.

25. (Twice Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

an elongate gear rack aligned along the displacement path;

guide means formed as a single unit [integral] with said elongate gear rack for guiding the cartridge access device along the displacement path;

a drive pinion mounted to the cartridge access device, said drive pinion engaging said elongate gear rack; and

pinion drive means operatively associated with said drive pinion for rotating said first drive pinion to move the cartridge access device along the displacement path.